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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/822,761 | 04/13/2004 | Zhiqing Zhang | 4533-0108PUS1 | 4958 |

2292 7590 09/18/2006

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EXAMINER

MCGARRY, SEAN

| | |
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| ART UNIT | PAPER NUMBER |
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1635

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,761

Applicant(s)

ZHANG ET AL.

Examiner

Sean R. McGarry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I and SEQ ID NO 25 in the replies filed on 1/10/06 and 4/13/06 are acknowledged. The traversal is on the ground(s) that set forth in applicants response filed 1/10/06. This is not found persuasive because of the reasons of record set forth in the communication mailed 3/13/06.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2 and 9 and SEQ ID NOS: 1-24 and 26-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the replies filed on 1/10/06 and 4/13/06.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

It is difficult to ascertain from the claims as a whole and in view of the specification whether it is intended that applicant is claiming individual aptamers or intends to claim various groups within the group of SEQ IDs recited in the claims, for example.

In claim 3, it is not clear whether applicant intends to limit the claim to select from SEQ ID NO: 19 (the sequence of III) and SEQ ID NO: 25 (the sequence of IV) or whether that which is claimed should have a secondary structure such as that depicted in III or IV. It is noted, however, that with applicants' election of SEQ ID NO: 25, the limitations as set forth in the claim 3 do not provide a further limitation.

Claim 4 recites "the oligonucleotide sequences as recited in claim 1 including a homologue oligonucleotide sequence that has 70% homologue with and function identical to the oligonucleotide sequence" It is not clear which oligonucleotide "the oligonucleotide" refers to, for example.

It is unclear in claim 5, what is intended by the term "truncated oligonucleotide". It is noted that SEQ ID NO: 25 is described in the specification at page 14-15 to be a "truncated" oligonucleotide. It is not clear, for example, if the claim is refereeing to those sequences recited that are "truncated" as described in the specification or, for example if the claim refers to truncations of those recited SEQ IDs.

It is noted that Claim 5 recites "the oligonucleotides sequence" there is lack of antecedent basis for this recitation. Furthermore claim 5 recites "the oligonucleotide sequence at the end of line 2. It is unclear what oligonucleotide sequence is being referred to.

It is noted that the claims appear to interchange the terms “oligonucleotide sequences”, “oligonucleotides sequence”, “oligonucleotides sequences”, and “oligonucleotide sequence”. The use of these terms throughout the claims has presented many antecedent basis problems and makes it difficult to determine what is being claimed.

In addition to the issues described directly above, claim 7 also recites the term “under strict condition”. This is not a term of art and applicant provides no definition for this term. The examiner cannot make a reasonable interpretation of the meaning of this term without making assumptions.

Claim 8 refers to “a derivated oligonucleotide sequence from the oligonucleotides sequence as recited in claim 1. first and again, it is unclear what “oligonucleotides sequence” is referred to and further there is no indication of what is intended to be embraced by the term “derivated oligonucleotide”

Applicant should take the time to present the claims such that they conform with current U.S. practice. Applicant must correct all grammatical and idiomatic errors of which not all have been pointed to specifically in this Official Action.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence

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And/Or Amino Acid Sequence Disclosures. Claims 2 and 3, and pages 3 and 4 of the specification recite and disclose sequences that are not accompanied by the required sequence identifier. The sequences depicted as I, II, III, and IV require sequence identifiers. It is noted that pages 10 and 13 of the specification provide identification of these sequences, for example. The Application therefore fails to comply with 37 CFR 1.821(d).

[37 CFR 1.821 - 1.825]. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g).

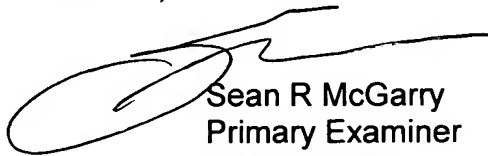
SEQ ID NO: 25 has been searched and found free of the prior art. Claims directed to an aptamer of SEQ ID NO: 25 or to a group of aptamers comprising SEQ ID NO: 25 would be free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean R. McGarry whose telephone number is (571) 272-0761. The examiner can normally be reached on M-Th (6:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sean R McGarry
Primary Examiner
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